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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/568,777	12/07/1995	RONALD L. SMITH	TI-22187	7439

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

MYERS, PAUL R

ART UNIT PAPER NUMBER

2112

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/568,777

Applicant(s)

SMITH ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19, 21-23, 28 and 30-46 is/are rejected.
- 7) ☒ Claim(s) 20 and 24-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/22/04 have been fully considered but they are not persuasive.

In regards to applicants arguments regarding claims 8-11: The examiner recognizes he incorrectly canceled claims 8-11. The examiner attempted to reinstate these claims when he asked the director for permission to reopen. However the director pointed out that the applicants accepted the canceling of the claims in the paper of 3/04/03, and the examiner could no longer correct his mistake and reinstate these claims. In consulting with the SPRE shop the examiner was instructed to treat the applicants attempt to reinstate the cancelled claims as an amendment adding these claims as new claims and renumber them appropriately.

In regards to applicants argument that because Sainton teaches a cable connecting the computer to the radiotelephone, Sainton does not teach directly connectable: A person of ordinary skill in the art would recognize that a conducting element (which is what a cable is) connecting two components together is a direct connection between the components. For example the definition of a direct connected modem is "A modem that uses standard telephone wire and connectors and plugs directly into a telephone jack, eliminating the need for an intermediary telephone." (Microsoft Press Computer dictionary). A direct connection simply requires there be no intervening circuitry. Sainton's modem is directly connectable through a cable to a telephone. If the applicants wish to claim this direct connection means there is no conducting element connecting the computer to the telephone applicants need only claim this, and indicate where support for this lack of a conductive element is in the specification.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 8-11 have been renumbered 43-46 respectively.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15, 17, 19, 22-23, 28, 30-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Sainton PN 5,249,218.

In regards to claims 15, 30, 38: Sainton teaches a computer (104) comprising: a provision for user input (keyboard); a provision for output (display); a microprocessor (106) coupled to said user input and said output; and an interface (110); coupled to said microprocessor (106), said interface being directly connectable to a corresponding interface (118) in a portable telephone (116), wherein said interface comprises at least one voice channel lead (RX/SPK), one

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command channel lead (DIO/DATA), and a ground/reference lead (GND) for connection to corresponding leads in a corresponding interface in said portable telephone.

In regards to claim 17: Sainton teaches the command channel being a bidirectional half-duplex signal line (Column 13 lines 10-14).

In regards to claims 19 and 28: Sainton teaches the voice channel used for Data/Audio (Column 12 line 50 to Column 13 line 16). Sainton also indicates the audio is digitized voice (Column 11 lines 14-33).

In regards to claim 22: Sainton teaches said interface further including a second voice channel lead (TX/TXAF) (Column 3 lines 64-65 Table 2 and Column 13 lines 10-16).

In regards to claim 23: Sainton teaches the voice channel leads facilitating a unidirectional full duplex mode (While Sainton does not use the words unidirectional full duplex Sainton teaches two separate wires one input and one output RX and TX. Which are for receiving and transmitting data respectively Column 5 lines 59-60 and Column 10 lines 50-60 thus unidirectional and transmits and receives data thus full-duplex Column 17 lines 32-35)

In regards to claim 31: Sainton teaches a keyboard (Column 4 line 55 to Column 5 line 9).

In regards to claim 32: Sainton teaches a display (Column 4 lines 55 to Column 5 line 9). The examiner further notes the telephone is a cellular telephone which would also include a keyboard and display.

In regards to claim 33, 36, 39, 42: Sainton teaches one apparatus being a computer (104).

In regards to claim 34, 35, 37, 40, 41: Sainton teaches one apparatus being a radio telephone (116).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Kyu et al PN 4,225,919.

In regards to claims 16 and 21: Sainton teaches the voice channel being unidirectional full-duplex (With TX/TXAF being the second channel See figure 3) instead of bidirectional half-duplex. Kyu et al teaches two basic types of data links are well known, including both bidirectional half-duplex and unidirectional full-duplex (See figures 2A and 2B and Column 7 lines 39-42). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use bidirectional half-duplex because this would have decreased the number of required signal lines (As shown in Figure 2A with only 1 signal line and Figure 2B with 2 signal lines).

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Dent et al PN 5,581,597.

In regards to claim 18: Sainton teaches the interface described above. Sainton does not teach the interface including a power line. Dent et al teaches (Column 8 lines 52-57) a cellular terminal (such as a cellular telephone) that is powered by an external signal line while the

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cellular terminal is “parked”. It would have been obvious to include a power signal line because this would have allowed for recharging the cell phone (Figure 3 battery charger 153).

8. Claims 43-44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090.

In regards to claim 43: Sainton teaches the computer system attached to a cellular telephone as described above. Sainton does not expressly teach said interface is located within a cavity in said computer. Morris teaches a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include a cavity for holding the cellular telephone because this would have allowed for separability between the computer and the cell phone (See Morris Column 1 lines 30-36). Further, Sainton and Morris are in the same field of endeavor in that both references seek to provide mobile communications capability in a portable computer environment.

In regards to claim 44: Morris teaches the portable telephone fits at least partially within said cavity.

In regards to claim 46: Morris teaches a mechanism on said computer (30) that cooperates with a corresponding mechanism (46) for removably securing said portable telephone to said computer (see figure 6).

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9. Claims 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to claim 43 above and further in view of Kobayashi PN 5,111,361.

In regards to claim 45: Sainton in view of Morris teaches the computer with a cellular telephone housed within a cavity of the computer as described above. Morris does not expressly teach that the cellular telephone can fit completely within the cavity of the computer. Kobayashi teaches a notebook computer in which the battery pack (21) fits completely within a cavity for holding the battery pack (Flush with the surface). It would have been obvious to fit Morris's cellular telephone completely within the computer flush with the surface because this would have been aesthetically pleasing.

10. Claims 43-44, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hop PN 4,912,756 in view of Morris PN 5,020,090.

In regards to claim 43: Hop teaches a computer comprising a provision for user input (keyboard); a provision for output (display); a microprocessor coupled to said user input and said output ; and an interface (COM1) coupled to said microprocessor (2), said interface being directly connectable to a corresponding interface in a portable telephone (3). The examiner notes the BPAI decision finding that Hop teaches the above (see Paper #17 mailed 3/8/02 Page 3 last 2 lines to page 5 line 2). Hop does not teach said interface is located within a cavity in said computer. Morris teaches a laptop computer including an interface (94) located within a cavity (mounting Track Figure 2) for holding a cellular telephone. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include a cavity for holding the

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cellular telephone because this would have allowed for separability between the computer and the cell phone (See Morris Column 1 lines 30-36). Further, Hop and Morris are in the same field of endeavor in that both references seek to provide mobile communications capability in a portable computer environment.

In regards to claim 44: Morris teaches the portable telephone fits at least partially within said cavity.

In regards to claim 46: Morris teaches a mechanism on said computer (30) that cooperates with a corresponding mechanism (46) for removably securing said portable telephone to said computer (see figure 6).

11. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hop in view of Morris as applied to claim 43 above, and further in view of Kobayashi PN 5,111,361.

In regards to claim 45: Hop in view of Morris teaches the computer with a cellular telephone housed within a cavity of the computer as described above. Morris does not expressly teach that the cellular telephone can fit completely within the cavity of the computer. Kobayashi teaches a notebook computer in which the battery pack (21) fits completely within a cavity for holding the battery pack (Flush with the surface). It would have been obvious to fit Morris's cellular telephone completely within the computer flush with the surface because this would have been aesthetically pleasing.

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Allowable Subject Matter

12. Claims 20, 24-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The examiner notes Sainton teaches a single lead set (RX/SPK in and TX/TXAF out) which handles both voice and data. The examiner found no prior art that discloses the voice channel lead and the data channel lead as separate leads and that taught a second command channel.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

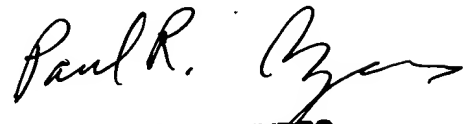
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 571 272 3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
April 27, 2005


PAUL R. MYERS
PRIMARY EXAMINER